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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,553	11/24/2003	Yves Farys	P24472	1817

7055 7590 02/17/2006

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/718,553	Applicant(s) FARYS ET AL.	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 14-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 14, 2005. Applicant's arguments with respect to the restriction in general are not persuasive. Applicant argues that there would be no burden on the examiner to examine all the species yet applicant requests that class 36 subclass 102 be searched with what was already previously searched by the examiner. This, in and of itself, shows a burden placed upon the examiner to search an area not necessary to have been searched previously. In the arguments of traverse presented in the submission of November 14, 2005, applicant argues that limitations present in the second invention were present in claim 7 of the original claims. These limitations appeared in original claim 7 except for the fact that all the limitations of claim 1 do not appear in claim 14 as now presented. In other words, one can infringe one of the inventions without infringing the other inventions, which clearly show distinctness and require restriction. The same is true with respect to invention III. For clarification, the restriction should have been with respect to related products (see MPEP 806.05(j)). The following is a restriction based upon this section. This restriction is not made final and can be traversed by applicant.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: Claims 1-13, drawn to an article of footwear with a flexible upper, tightening arrangement on the upper, a heel stiffener with lateral walls with a recess in each lateral wall and a strap affixed to the recesses, classified in class 36, subclass 69.

Invention II: Claims 14-16, drawn to an article of footwear with a tightening arrangement provided on the upper, a molded heel stiffener with lateral walls and a base and an outer sole attached to the base, classified in class 36, subclass 68.

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Invention III: Claims 17-20, drawn to an article of footwear with a flexible upper, a tightening arrangement on the upper, a molded heel stiffener with upstanding lateral walls with a notch located between the lateral walls and an outer sole beneath the lateral walls, classified in class 36, subclass 102.

3. Inventions I, II and III are directed to related products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e. are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function or effect. See MPEP § 806.05(j). In the instant case, the inventions do not overlap in scope as some limitations in one invention is not required for the other inventions. The inventions are not obvious variants because each invention acts differently when used. The inventions have materially different designs in that the first invention requires recesses in the walls of the heel stiffener with the strap attached therein. This is not required of the other inventions. The second invention requires only an upper, a molded heel stiffener (no recesses or straps in recesses), lateral walls and a base and an outer sole attached to the base. The third invention requires notches in the lateral walls of the heel stiffener, clearly not a requirement of the other inventions. Therefore, each invention as claimed has separate use. The first invention gives variable support to the user's heel by use of the strap in the recesses. The second does not have that variable support and only varies the thickness of the sole. The third invention has the notches that allow for flexibility of the heel support, which flexibility is not required by the other inventions. Therefore, restriction is deemed proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter, and the search required for one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

Claim Rejections - 35 USC § 112

5. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 8 of claim 1, the phrase “on each of said first lateral walls.” is not clearly understood. It appears applicant is missing the terms --and second-- after first. There is insufficient antecedent basis for more than one first lateral wall. This also occurs between lines 9 and 10 of claim 1 as well. For purposes of examination, it will be assumed applicant meant first and second lateral walls.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 5 contains the phrase “at least one housing” in line 2 of the claim. There is no support in the specification as originally filed for only one housing (the specification clearly states housings in the plural form) and therefore, this claim language is not supported by the specification. .

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-3 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulier 4,622,764 in view of WO 93/25107 (WO '107). Boulier '764 discloses all the limitations substantially as claimed including the following: a flexible upper 18; a tightening arrangement (see Figure 9, lacing of upper) provided on the upper to tighten the foot within the upper; the upper comprising a molded heel stiffener 1; the heel stiffener having a first lateral wall (1 on left side of Figures 2-6) extending along a first lateral side of the upper, a rear wall (located behind heel) extending along a rear of the upper, a second lateral wall (1 on right side of Figures 2-6) extending along a second lateral side of the upper; an outer sole 20; the heel stiffener comprises a base 2 extending substantially forwardly from the rear wall up to an area of a front limit of a plantar arch of a wearer (see Figure 7); the two lateral walls 1 of the heel stiffener adapted to protect rear portions of the first and second lateral sides of the upper (see Figures 7 and 10); the heel stiffener includes housings (i.e., at least one if there are more than one) for positioning and adhesively securing at least a rear portion of the outer sole (see Figure 7, recesses shown on bottom of heel cup with sole pieces in the recesses); the heel stiffener is made of rubber (see col. 3, lines 2-6); the outer sole comprises two portions with different thicknesses (see Figure 7, heel portion is one thickness and toe portion is a thinner thickness); front portion of the sole has a thickness greater than a thickness of a rear portion of the sole (see Figure 7, front portion where 14 ends near the arch, this portion is greater in thickness than the heel portion behind 21 in the heel and moving up the heel of the user); rear portion of sole extends beneath base of stiffener (see Figure 7); front portion of sole is at least twice the thickness of the rear portion of the sole (See Figure 7 as noted above); the rear portion of the sole appears to be 2mm;. With respect to claim 8, the forming and fastening of the shoe would appear to meet the limitations of this claim. Boulier '764 does not teach at least one recess on each of the first (and second) lateral walls and a strap affixed upon the heel stiffener within the recesses in the first and second lateral walls of the heel stiffener and extending around the rear of the upper or the front straps. WO '107 teaches that recesses 21 can be located in a heel counter of a shoe. Inside these recesses, a strap 19 can be located. This strap,

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after passing through a recess on one side of the shoe can pass around the heel of the user to the other side of the shoe and through the other recess (see Figures 7, 8 10). This strap aids in firmly and adjustably holding the user's foot to the shoe upper. WO '107 further teaches a front protection strip (that located above lead line 2 in Figure 2 and below portion 3) affixed to the lower portion of the upper and having a pair of arms extending rearwardly along the first and second lateral sides of the upper (see Figure 2). Each of the pair of arms of the front protective strip is overlapped by respective portions of the strap 19 on the first and second lateral sides of the upper to give support to the upper. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a strap in recesses in the heel counter and front straps on the sole, as shown in WO '107, on the sole of Boulrier '764, as taught by WO '107, to aid in holding the upper and heel counter closer to the user's foot and to be able to adjust the tension and thereby the support of the heel counter.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Chen 2003/0208931 (Chen '931). The references as applied above disclose all the limitations of the claim except for the heel stiffener comprising a pivoting recess at a junction of the lateral edges and the rear wall. Chen '931 teaches that a heel counter 30 can have a recess 3022' between the lateral wall 3021' and the rear wall 3023' allowing the opposite parts to flex in different directions. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a flex groove, such as that taught by Chen '931, between the lateral walls and the rear wall of the heel stiffener of Boulrier '764 to allow the heel stiffener to support the user's heel but still flex through the gait of the user.

Response to Arguments

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Anthony Stashick". The signature is written in a cursive, flowing style with a large initial 'A'.

Anthony Stashick
Primary Examiner
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ADS